

30 AUG 2005

#7



UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

JACOBSON HOLMAN PLLC
400 7th Street, N.W. Suite 600
Washington, DC 20004

In re Application of	:	
Kleran John TRASS	:	DECISION ON
Application No.: 10/522,981	:	
PCT No.: PCT/NZ03/00004	:	
Int. Filing Date: 22 January 2003	:	REQUEST UNDER
Priority Date: 02 August 2002	:	
Attorney's Docket No.: P70401US0	:	
For: BOARD GAME	:	37 CFR 1.497(d)

This is a decision on applicants' "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C.371" filed on 18 July 2005, which is being treated as a request under 37 CFR 1.497(d) requesting adding inventor, Steven John McMenemy, in the executed declaration.

BACKGROUND

On 22 January 2003, applicant filed international application No. PCT/NZ03/00004 designating the United States and claiming a priority date of 22 January 2003. A copy of the intentional application was transmitted on 12 February 2004 to the USPTO from the International Bureau.

On 02 February 2005, applicant filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter were, *inter alia*, the requisite basic national fee, and the international application. No executed declaration or oath was submitted at such time.

On 02 May 2005, applicant filed a Transmittal of Missing Requirements of Application, which included an executed declaration that contained two inventors.

On 20 May 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, *inter alia*, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by International application number and international filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it: The second inventor's name is not listed on the published International Application.

On 18 July 2005, applicants filed the present request to add inventor, Steven John McMenemy, in the executed declaration because by error and without deceptive intent he was not named as an inventor.

DISCUSSION

A submission under 37 CFR 1.497(d) must include:

- (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (2) the fee set forth in § 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR §3.73(b) of this chapter).

A review of the application file reveals that applicants have satisfied item (1) but not items (2) and (3) under 37 CFR 1.497(d).

With respect to item (1), a statement has been submitted by Steven John McMenemy stating that the error in inventorship occurred without a deceptive intent.

With respect to item (2), the processing fee has not been provided.

With respect to item (3), the assignee, Hybrid Edutainment Limited, consents to the addition Steven John McMenemy. However, there is no copy of the executed assignment to the assignee in the file. To establish the right of the assignee to take action, applicants must submit a copy of the executed assignment or specify the reel and frame number. Note MPEP 324 and 37 CFR 3.73(b).


Accordingly, the request does not meet the requirements under 37 CFR 1.497(d).

CONCLUSION

For the reasons above, the request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459